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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,876	06/11/2001	Sean S. Jensen-Grey	PU010088	2637

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EXAMINER

AMSBURY, WAYNE P

ART UNIT	PAPER NUMBER
2171	8

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 09/878,876	Applicant(s) JENSEN-GREY, SEAN S.	
Examiner Wayne Amsbury	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 April 2002.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10/9/01 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

CLAIMS 1-16 ARE PENDING

1. Claims 1-8 are objected to because of the following informalities:

In claim 1 line 3, "one of a search term"

In claim 8 line 2, "in system"; line 5 "every of"; line 12-13 "at least search term".

Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "said at least one search term" in lines 7-8. **There is insufficient antecedent basis for this limitation in the claim.**

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the independent claims fail to provide a nexus between providing at least one search term [see line 3 claim 1] and the search result addressed in the remainder of the claim. **In the interest of compact prosecution**, it is assumed that the search result is derived from application of the search term.

All of the independent claims contain an infinite loop in the process described. Using claim 1 as an example, the parsed metadata, derived from a presumed search of an initial term is said to determine the initial term itself.

In the interest of compact prosecution it is considered that there are precisely two searches claimed, one of an initial search term and another determined from parsed metadata derived from the initial search.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In independent **claim 9**, the context of “program readable medium” is not statutory, as opposed to the MPEP 2106 guideline: “computer readable medium”. A program *per se* is an abstraction, possibly a conceptual plan, not necessarily in the technological arts.

In claim 16, a “method” is an abstraction, as opposed to the MPEP 2106 guideline: --computer-implemented method--.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al (Hanson), US 6,490,585, 3 December 2002.

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Hanson receives a search request, typically embodied in JAVA script, that includes search terms and is interpreted in relation to metadata at a number of locations [FIG 4 & 13, COL 4 line 63 to COL 5 line 67].

As to **claims 1-2**, the initial request is used to search a repository 18 [COL 5 lines 24-33] for metadata that corresponds to metadata associated with a search result. This is in turn used to search the individual databases [COL 5 lines 12-23]. Parsing is inherent in deriving terms embedded in the script and data objects [COL 6 lines 25-34 and elsewhere].

As to **claim 3**, several of the databases noted in Hanson are relational databases, SQL is explicitly applied at COL 10 line 60 and after, and the use of relational database objects are noted at COL 9 lines 18-21.

As to **claims 4 and 7**, the databases are accessed through a browser [FIG 6 and elsewhere].

As to **claims 5-6**, Hanson is clearly intended for media [COL 1 lines 19-30 and elsewhere].

The elements of **claims 8-16** are rejected in the above analysis and these claims are rejected on that basis.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

WPA
July 8, 2003


WAYNE AMSBURY
PRIMARY PATENT EXAMINER